



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,472	06/27/2000	William R. Van Etten	65545-0074	5091

10291 7590 08/20/2002

RADER, FISHMAN & GRAUER PLLC
39533 WOODWARD AVENUE
SUITE 140
BLOOMFIELD HILLS, MI 48304-0610

EXAMINER

KERR, DEBRA E

ART UNIT PAPER NUMBER

3625

DATE MAILED: 08/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary	Application No.	Applicant(s)	
	09/604,472	VAN ETEN ET AL.	
	Examiner	Art Unit	
	Debra E Kerr	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-16 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-16 of copending Application No.09/348,693. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3625

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 9 refers back to claim 1 and recites "said predetermined relationships", which lacks proper antecedent basis. Modifying claim 9 to recite -- claim 2 -- would have proper antecedent basis. Appropriate correction is required.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 8-10, and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Povilus (US 5,740,425) in view of Dudle et al. (US 5,570,291).

As per claim 1, Povilus discloses a procurement system for purchasing a special item, comprising a buyer for purchasing the special item (col. 22, line 40-44), a supplier for supplying the special item to said buyer (col. 44, lines 19-22), and a fulfillment organization for communicating between said buyer and the supplier (col.44, lines 23-28), a database associated with said fulfillment organization (col. 13, lines 26-27), and

Art Unit: 3625

updated information which is added to the database for future reference (col. 36, lines 18-45). Povilus fails to teach a special requisition or updating a database with information which is obtained from the special requisition. Dudle teaches a Custom Order Entry subsystem and Forms Management subsystem that allow customers to create custom orders for special items, which can then be added to the database for processing future orders (col. 4, lines 5-6 and col. 9 line 66 – col. 10 line 34). It would have been obvious to one having ordinary skill in the art to combine Povilus's method for publishing electronic catalogues with Dudle et al.'s custom product ordering system so that a customer could create a special requisition for an item not found in a catalog, and then add the item specification to an item database for future reference. Doing so would increase customer satisfaction by allowing a manufacturer to rapidly fill repeat orders for a custom product.

As per claim 2, Povilus teaches an electronic multi-manufacturer product catalog (col. 3, lines 20-24), comprising a knowledge base containing predetermined rules (col. 13, lines 25-35) which is linked to a product database (col. 13, lines 29-30) containing normalized product data represented by unique stock keeping unit (SKU) numbers (col. 17, lines 42-44) based on predetermined relationships (col. 17, lines 33-39) in accordance with predetermined rules stored within the knowledge base (col. 14, lines 25-39).

As per claim 3, Povilus teaches an electronic catalog which allows a customer to combine multiple normalized SKUs to configure a special requisition of a custom product with enhanced form or functionality which will be designated by a new

Art Unit: 3625

normalized SKU (col. 22, lines 40-53) which constitutes a unique description of the special item.

As per claim 8, Povilus discloses a system where the updated special item information is normalized according to predetermined rules and stored within the catalog database (col. 21, lines 32-34 and col. 22, lines 10-19).

As per claim 9, Povilus teaches an electronic catalog which comprises predetermined relationships including class (col. 13, line 52 – col. 14, line 12), attribute (col. 14, lines 13-18) and value characteristics (col. 15 lines 23-32).

As per claim 10, Povilus teaches a procurement system including a normalized catalog database with unique items identified by class, attribute and value relationships (col. 3, lines 10-13 and col. 17, lines 42-46), a knowledge base with a set of predetermined rules for converting free form catalog information into the normalized catalog database (col. 14, lines 25-33 and col. 19, lines 64-67), and an item selection procedure for locating a desired item within the catalog database (col. 48, lines 4-36). Povilus fails to teach an item specifying procedure that is invoked when the desired item can't be located in the catalog. Dudle teaches a system that allow customers to create custom orders for special items in addition to a catalog of off-the-shelf products (col. 8, lines 32-36), which can then be added to the database for processing future orders (col. 10 lines 31-34). It would have been obvious to one having ordinary skill in the art to combine the electronic catalog of Povilus with Dudle et al.'s custom product ordering system so as to provide a customer with an item specifying procedure for an item not found in a catalog, thereby increasing customer satisfaction.

As per claims 11 and 12, Povilus substantially discloses the invention but does not disclose a procurement system where a structured requisition with a new class, attribute or value added to preexisting relationships to uniquely identify a desired item is automatically sent to suppliers who were identified by the relationships used to create the structured requisition. Dudle et al. disclose a system wherein a structured requisition is created by modifying an existing item specification which is stored in the database (col. 11, lines 57-63), and wherein a supplier for a structured requisition can be identified based on analysis of which supplier is equipped to most efficiently produce the custom item specifications stored in the database (col. 8, lines 14-24), and can be automatically selected by the system in the course of generating a production order (col. 15, lines 41-44 and 52-54). It would have been obvious to one having ordinary skill in the art to combine Povilus's method for publishing electronic catalogues with Dudle et al.'s custom product ordering system so that a customer who wishes to place a special order can do so directly from the online catalog system and save time.

As per claims 13 -16, Povilus substantially discloses the invention, including a new predetermined rule which uniquely identifies a desired item being added to a knowledge base to provide an update to class, attribute and value relationships (col. 41, lines 31-47), storing identifying information concerning the desired item in the database in accordance with predetermined relationships (col. 34, lines 13-36), and a new desired item becoming a catalog item available through the selection procedure (col. 34, lines 28-30 and col. 43, lines 27-30). Povilus does not disclose a system where a structured requisition is used to develop a new predetermined rule for uniquely

Art Unit: 3625

identifying the desired item. Dudle et al. disclose a system with a rules selection subsystem which allows users to add rules as guidelines for creating a custom matrix for a specific customer and storing the rules in the database for future reference (col. 18, lines 4-15). It would have been obvious to one having ordinary skill in the art to combine Povilus's method for publishing electronic catalogues with Dudle et al.'s custom product ordering system so that a manufacturer of a custom item can make its catalog customers aware that the new product exists for the purpose of increasing sales.

Povilus fails to teach processing a request for a special item not located within the catalog database using the predetermined relationships. Dudle teaches a customer or sales representative processing a custom order for a business form that is not located in the electronic database, such as creating the form using form design software. Use of such software requires the application of standard rules and procedures that would apply to any custom form being designed (col. 9 line 65 – col. 10 line 34). It would have been obvious to one having ordinary skill in the art to combine the electronic catalog of Povilus with Dudle et al.'s custom product ordering system so that a custom item can be rapidly added to a catalog using predetermined schema, thereby enabling catalog customers to access a new product for the purpose of increasing sales by selling to a wider market.

Claims 4- 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Povilus in view of Dudle et al., and further in view of Conklin et al. (US Patent No. 6,338,050).

Povilus substantially discloses the invention, including adding a new predetermined rule to uniquely identify a special item (col. 34, lines 13-36 and col. 36, lines 18-39), and a fulfillment organization normalizing the updated data received from the supplier (col.34, lines 22-30) based on identical classes and attributes (col. 36, lines 18-22 and lines 34-40). Povilus does not specifically teach a special requisition including a proposed modification to a predetermined relationship, a supplier reviewing the special requisition, basing the new predetermined rule on updated information within a special requisition, or a buyer comparing the updated information as a basis for comparison between each special item available for purchase. Dudle et al. teaches a product estimating and order processing system in which custom item specifications are stored for use as a template for designing further custom business forms (col. 10. lines 27-34), and which allows for a supplier to review a custom product order and make changes as needed (col. 14, lines 47-67). It would have been obvious to one having ordinary skill in the art to combine Povilus's method for updating an electronic catalog to reflect a new product offering with Dudle et al.'s custom order processing system in order to allow a manufacturer to quickly add a new item produced for a special requisition to its online catalog in order to sell to the general public instead of selling only to the buyer who requested the product initially, thereby generating increased revenue into the future.

Povilus and Dudle et al. do not teach a system where a plurality of suppliers review a special requisition and forward updated information for comparison by the buyer. Conklin et al. disclose a multivariate negotiations engine which allows a buyer to submit a Request for Proposal or Request for Quote to multiple sellers (col. 20, lines 23-30) (col. 6, lines 19-20 and 25-32). It would have been obvious to one having ordinary skill in the art to combine Conklin et al.'s multivariate negotiations engine with Povilus's method for updating an electronic catalog and Dudle et al.'s custom order processing system in order to allow multiple manufacturers to respond to a special requisition placed by a buyer and compete with each other on an equal footing in order to potentially increase each manufacturer's sales.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Povilus in view of Conklin et al. (US Patent No. 6,338,050).

Povilus substantially discloses the invention, including a system wherein suppliers are identified with specific predetermined relationships (col. 17, lines 49-54). Povilus does not teach a fulfillment organization selecting a plurality of suppliers to receive and review a special requisition. Conklin et al. disclose a negotiations system which comprises a sponsor who creates and administers a negotiation engine for participation between buyers and sellers (col. 14, lines 1-19), including setting rules for supplier participation to determine that a supplier can fulfill a buyer's requirements (col. 28, lines 46-51). It would have been obvious to one having ordinary skill in the art to combine Povilus's method for publishing electronic catalogues with Conklin et al.'s

Art Unit: 3625

negotiation engine in order to create a commercial community with a set of rules administered impartially for buyers and sellers by an administrator.

Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Povilus in view of Chipman et al. (US 6,292,894), and further in view of Henson (US 6,167,383).

Povilus substantially discloses the claimed invention, including a buyer, multiple catalog databases(see Fig. 15 showing product database 253 and electronic catalog 256 with links to other databases showing pricing and availability – see also col. 17, lines 46-50), a catalog database containing unique catalog items identified with respect to class, attribute and value relationships, and an item selection procedure. Povilus fails to teach a procedure that searches for an item in a second database when it is not in a first database. Chipman teaches an Internet-based cataloguing system which includes multiple catalogues, each categorized by standard class, attribute and method parameters (col. 4, lines 9-21). Legacy databases are used as master databases to provide product data to build a web page, which is then transferred to a web server for Internet access by potential customers. The system includes means to search additional databases, such as the legacy master databases described above, for further information when adequate information is not found through an initial search of the catalog portal (col. 10, lines 21-49). It would have been obvious to one having ordinary skill in the art at the time of the invention to combine Povilus's catalog publishing system with the teaching of Chipman regarding searching through additional catalogues if a

Art Unit: 3625

primary catalog does not fulfill the search request. Doing so would provide a means for a customer to locate an item and increase sales for the suppliers of the catalogues.

Povilus and Chipman fail to teach a special requisition prepared by a buyer, or forwarding a special requisition to a supplier who provides the desired item and updates a database with the desired item. Henson teaches a system for configuring a custom computer system online and placing an order for the system with the supplier, who then builds the system to the customer's order and ships it to the customer (see Fig. 5, Fig. 9). It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the systems of Povilus and Chipman with the teaching of Henson regarding a system for supplying a special requisition. Doing so would enable a user to search for a custom product in multiple databases and order such a product when found, allowing a supplier to increase sales by selling to a specialty customer base.

Please note that although Henson is silent regarding updating a database with an item defined by a special requisition, storing a customer's order data in a database for future reference when the order is filled is old and well known, and doing so constitutes an essential function of Henson's system, without which the system would be useless. It would have been obvious to one skilled in the art to store the special requisition in an order database so that it could be forwarded to a supplier at a remote site for the purpose of building the custom system correctly and shipping it to the customer, thereby ensuring customer satisfaction.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

King, Jr. et al. teach a system for ordering items using an electronic catalog.

Gardner et al. teach an electronic requisition and authorization process.

Walker et al. teach a commercial network system designed to facilitate buyer-driven conditional purchase offers.

Geier et al. teach an order entry system having catalog assistance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra E Kerr whose telephone number is (703) 305-3184. The examiner can normally be reached between the hours of 7 a.m. and 4:30 p.m. Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 305-1440. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9000.

Application/Control Number: 09/604,472


Page 13

Art Unit: 3625

Debra E. Kerr

DEK

August 12, 2002


JEFFREY A. SMITH
PRIMARY EXAMINER